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10/816,014	04/01/2004	Raymond B. Ryan	Ryan --P1-04	9572
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PETER K. TRZYNA, ESQ. P O BOX 7131 CHICAGO, IL 60680			EXAMINER MERCHANT, SHAHID R	
			ART UNIT	PAPER NUMBER
			3694	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/816,014

Applicant(s)

RYAN, RAYMOND B.

Examiner

Shahid R. Merchant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/1/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Examiner has given consideration to applicant's Provisional Application No. 60/459,718 filed on April 1, 2003. For examining purposes of this application, the effective filing date will be April 1, 2003.

Claim Objections

2. Claim 14 objected to because of the following informalities: the phrase "the loan related to the benefit play by said loan..." is unclear and ambiguous. Examiner believes the word play should be changed to plan. Appropriate correction is required.

3. Claim 21 (22) objected to because of the following informalities: applicant has two claim 21's. For examining purpose, Examiner is assuming that the second claim 21 should read claim 22. Therefore, claim 22 reads The method of claim 20, further including the step of: transferring at least one financial performance item to at least one party with an interest in the benefit plan.

4. Claim 22 objected to under 37 CFR 1.75 as being a substantial duplicate of claim 20. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

5. Claim 23 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim *should refer to other claims in the alternative only*. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 20, 21, 42 and 44 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "financial performance item" is vague and ambiguous.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 9-13, 23, 32-35 and 45 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

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matter which applicant regards as the invention. ERISA is a federal law that has changed several times since being introduced in 1974. Therefore, ERISA is indefinite because it can change over time.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 36-45 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 36-45 are directed to non-statutory subject matter. Computer programs *per se* are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760. See MPEP § 2106 .01 [R-5].

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-45 rejected under 35 U.S.C. 103(a) as being unpatentable over T.

Rowe Price (see attached PTO-892, Ref U) in view of Ford (see attached PTO-892, Ref V).

14. As per claim 1, T. Rowe Price teaches computer-implemented method for monitoring sufficiency of collateral for a loan, the method comprising the steps of:

receiving a valuation of collateral for a loan, the loan at least partially funding acquisition of the collateral held, the collateral including at least one security;

determining a balance of the loan; and

comparing the balance of the loan to the valuation of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement permitted (see pages 3-4). T. Rowe Price does not explicitly teach linking a loan to a benefit plan.

Ford teaches the relationship of loans and benefit plans (see pages 47 and 49—Employee Stock Ownership Plan (ESOP) loan).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to acquire a loan using a participant's benefit plan as collateral because it would allow a participant to "sell short" a security and realize a profit as taught by T. Rowe Price (see page 5).

15. As per claim 2, T. Rowe Price and Ford teach the method of claim 1 as described above. T. Rowe Price further teaches including: signaling an incidence of noncompliance with the loan requirement (see pages 2-4).

16. As per claim 3, T. Rowe Price teaches the method of claim 2 as described above. T. Rowe Price further teaches including the step of: computing an amount of the collateral to be sold to retire debt to comply with a loan requirement (see pages 4-5).

17. As per claim 4, T. Rowe Price teaches the method of claim 2 as described above. T. Rowe Price further teaches including the step of: computing an amount of additional collateral required to comply with the loan requirement (see pages 4-5).

18. As per claim 5, T. Rowe Price and Ford teach the method of claim 1 as described above. T. Rowe Price further teaches wherein the step of comparing includes:

computing the actual ratio of the loan amount divided by the value of the collateral;

comparing an actual ratio to a test ratio; and

signaling when the actual ratio equals or exceeds the test ratio (see pages 4-6).

19. As per claim 6, T. Rowe Price and Ford teach the method of any one of claims 1-5 as described above. T. Rowe Price further teaches wherein the step of receiving a

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valuation of collateral carried out with said at least one security including at least one equity security, a put contract for a equity security, or a call contract for an equity security (see pages 1-3).

20. As per claim 7, T. Rowe Price teaches the method of claim 6 as described above. T. Rowe Price further teaches wherein the step of receiving a valuation of collateral is carried out with said at least one security including at least one of said equity security or said put contract for the equity security (see pages 1-3).

21. As per claim 8, T. Rowe Price teaches the method of claim 7 as described above. T. Rowe Price further teaches wherein the step of receiving a valuation of collateral is carried out with said at least one security including at least one said equity security (see pages 1-3).

22. As per claim 9, T. Rowe Price and Ford teach any one of claims 1-5. T. Rowe Price further teaches wherein the step comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement. T. Rowe Price does not explicitly teach the benefit plan being an ERISA benefit plan.

Ford teaches the benefit plan being an ERISA benefit plan (see page 65).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to

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compare the balance of a loan to a value of collateral within an ERISA benefit plan because it allows a participant to manage the level of risk in the value of the collateral as taught by T. Rowe Price (see page 2).

23. As per claim 10, T. Rowe Price teaches the method of claim 6. T. Rowe Price further teaches wherein the step comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement. T. Rowe Price does not explicitly teach the benefit plan being an ERISA benefit plan.

Ford teaches the benefit plan being an ERISA benefit plan (see page 65).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to compare the balance of a loan to a value of collateral within an ERISA benefit plan because it allows a participant to manage the level of risk in the value of the collateral as taught by T. Rowe Price (see page 2).

24. As per claim 11, T. Rowe Price teaches the method of claim 7. T. Rowe Price further teaches wherein the step comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement. T. Rowe Price does not explicitly teach the benefit plan being an ERISA benefit plan.

Ford teaches the benefit plan being an ERISA benefit plan (see page 65).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to

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compare the balance of a loan to a value of collateral within an ERISA benefit plan because it allows a participant to manage the level of risk in the value of the collateral as taught by T. Rowe Price (see page 2).

25. As per claim 12, T. Rowe Price teaches the method of claim 8. T. Rowe Price further teaches wherein the step comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement. T. Rowe Price does not explicitly teach the benefit plan being an ERISA benefit plan.

Ford teaches the benefit plan being an ERISA benefit plan (see page 65).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to compare the balance of a loan to a value of collateral within an ERISA benefit plan because it allows a participant to manage the level of risk in the value of the collateral as taught by T. Rowe Price (see page 2).

26. As per claim 13, T. Rowe Price and Ford teach the method of any one of claims 1-5. T. Rowe Price further teaches wherein the step comparing the balance of the loan to the value of the collateral to monitor sufficiency of the collateral for compliance with a loan requirement. T. Rowe Price does not explicitly teach the benefit plan being an ERISA benefit plan.

Ford teaches the benefit plan being an ERISA benefit plan (see page 65).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to compare the balance of a loan to a value of collateral within an ERISA benefit plan because it allows a participant to manage the level of risk in the value of the collateral as taught by T. Rowe Price (see page 2).

27. As per claim 14, T. Rowe Price teaches a computer-implemented method for illustrating a financial performance, the method including the steps of:

receiving data, the data including a valuation of collateral for a loan, the loan at least partially funding acquisition of the collateral, the collateral including at least one security, the loan having a balance sufficient for compliance with a loan requirement (see pages 3-4). T. Rowe Price does not explicitly teach linking a loan to a benefit plan and the generating of financial performance over time.

Ford teaches the relationship of loans and benefit plans (see pages 47 and 49) and generating an illustration of benefit plan financial performance over time (see pages 65-66).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to show benefit plan data and an illustration of benefit plan financial performance over time because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 65-66).

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28. As per claim 15, T. Rowe Price and Ford teach the method of claim 14 as described above. T. Rowe Price does not explicitly teach the following sub-steps: computing a simple accounting rate for return said participant's benefit plan; computing the plan's internal rate of return; computing the plan's present value gain or loss; computing the plan sponsor's GAAP cost; and computing the plan sponsor's present value cost.

Ford teaches computing a simple accounting rate for return said participant's benefit plan; computing the plan's internal rate of return; computing the plan's present value gain or loss; computing the plan sponsor's GAAP cost; and computing the plan sponsor's present value cost (see pages 65-66).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to illustrate a simple accounting rate for return said participant's benefit plan; the plan's internal rate of return; the plan's present value gain or loss; the plan sponsor's GAAP cost; and the plan sponsor's present value cost because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 65-66).

29. As for claims 16-19, the argument used for claim 15 as set forth above applies to claims 16-19 respectively.

30. As per claim 20, T. Rowe Price and Ford teach the method of claim 19 as described above. T. Rowe Price does not explicitly teach the step of: transferring at

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least one financial performance item to at least one party with an interest in the benefit plan.

Ford teaches the step of: transferring at least one financial performance item to at least one party with an interest in the benefit plan (see pages 46-72).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to transferring at least one financial performance item to at least one party with an interest in the benefit plan because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 46-72).

31. As per claim 21, T. Rowe Price and Ford teach the method of claim 1. Ford teaches a computer-implemented method of illustrating a comparison of at least one participant in a stock option plan to at least one participant in a participant's benefit plan of claim 1, the method including the steps of:

receiving financial performance data for a participant's benefit plan,;

receiving the financial performance data for a stock option plan; generating a comparison of the stock option plan and the benefit plan data; and

computing at least one difference between said stock option plan and said benefit plan (see pages 60-61 and 65-66).

Ford does not teach the benefit plan having collateral for a loan to the benefit plan, the loan at least partially funding acquisition of the collateral held by the benefit plan, the collateral including at least one security of a plan benefit sponsor.

T. Rowe Price teaches the benefit plan having collateral for a loan to the benefit plan, the loan at least partially funding acquisition of the collateral held by the benefit plan, the collateral including at least one security of a plan benefit sponsor (see pages 3-4)

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to show differences between a stock option plan and a benefit plan because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 46-72).

32. As per claim 22 (21), T. Rowe Price and Ford teach the method of claim 20 as described above. T. Rowe Price does not explicitly teach the step of: transferring at least one financial performance item to at least one party with an interest in the benefit plan.

Ford teaches the step of: transferring at least one financial performance item to at least one party with an interest in the benefit plan (see 46-72).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of T. Rowe Price and Ford to transferring at least one financial performance item to at least one party with an interest in the benefit plan because it would allow investors to easily see how a company manages its finances as taught by Ford (see pages 46-72).

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33. As per claim 23, Ford and T. Rowe Price teach the method of claim 21. Ford further teaches wherein at least one of the steps is carried out with the benefit plan being an ERISA benefit plan.

34. As per claim 24, it is in parallel with claim 1 and is rejected for at least the same reason as set forth above.

35. As per claim 25, it is in parallel with claim 2 and is rejected for at least the same reason as set forth above.

36. As per claim 26, it is in parallel with claim 3 and is rejected for at least the same reason as set forth above.

37. As per claim 27, it is in parallel with claim 4 and is rejected for at least the same reason as set forth above.

38. As per claim 28, it is in parallel with claim 5 and is rejected for at least the same reason as set forth above.

39. As per claim 29, it is in parallel with claim 6 and is rejected for at least the same reason as set forth above.

40. As per claim 30, it is in parallel with claim 7 and is rejected for at least the same reason as set forth above.

41. As per claim 31, it is in parallel with claim 8 and is rejected for at least the same reason as set forth above.

42. As per claim 32, it is in parallel with claim 9 and is rejected for at least the same reason as set forth above.

43. As per claim 33, it is in parallel with claim 10 and is rejected for at least the same reason as set forth above.

44. As per claim 34, it is in parallel with claim 11 and is rejected for at least the same reason as set forth above.

45. As per claim 35, it is in parallel with claim 12 and is rejected for at least the same reason as set forth above.

46. As per claim 36, it is in parallel with claim 14 and is rejected for at least the same reason as set forth above.

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47. As per claim 37, it is in parallel with claim 15 and is rejected for at least the same reason as set forth above.

48. As per claim 38, it is in parallel with claim 16 and is rejected for at least the same reason as set forth above.

49. As per claim 39, it is in parallel with claim 17 and is rejected for at least the same reason as set forth above.

50. As per claim 40, it is in parallel with claim 18 and is rejected for at least the same reason as set forth above.

51. As per claim 41, it is in parallel with claim 19 and is rejected for at least the same reason as set forth above.

52. As per claim 42, it is in parallel with claim 20 and is rejected for at least the same reason as set forth above.

53. As per claim 43, it is in parallel with claim 14 and is rejected for at least the same reason as set forth above.

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54. As per claim 44, it is in parallel with claim 20 and is rejected for at least the same reason as set forth above.

55. As per claim 45, it is in parallel with claim 23 and is rejected for at least the same reason as set forth above.

Conclusion

The following prior art, which is made of record but not relied upon, is considered pertinent to applicant's disclosure.

Ford Motor Company, Form 11-K, June 18, 2002, pages 1-19. (Ref. W)

Grant et al., U.S. Patent No. 5,878,405 (Ref. A)

Gilbert et al., U.S. Patent Application Publication 2003/0018557 (Ref. B)

The Electronic Investor: Marginal Costs by Theresa W. Carey, Barron's, October 16, 2000, Vol. 80, Iss 42, page 50. (Ref. X)

India: Borrowing Money to Pay for Stocks, Businessline, September 23, 2001, page 1. (Ref. Y)

Mutual Funds and 401K—An Agreeable Combination by Lauren Rudd, Savannah Morning News, May 22, 2000, page 9A. (Ref. Z)

Margin Calls, Sellouts Anger Some Investors by Christine Dugas, USA Today, April 11, 2001, Page B3. (Ref. ZA)

Pearson PLC, Form 20-F, June 10, 2002, pages F-20 to F-24 (Ref. ZB)

<http://web.archive.org/web/20010131095700/prudential.com/businesscenter/bczzz1009.html> (Prudential website), 1/31/2001, pages 1-3. (Ref. ZC)

<http://web.archive.org/web/20011216032658/www400.fidelity.com> (Fidelity website), 12/16/2001, pages 1-3. (Ref. ZD)

<http://web.archive.org/web/20011113215801/wps.fidelity.com/taxexempt/employer/956945589826/971289937731.htm> (Fidelity website), 11/13/2001, pages 1-2. (Ref. ZE)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid R. Merchant whose telephone number is 571-270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammel can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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SRM



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PRIMARY EXAMINER